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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,637	12/08/2003	Randy G. Cooper	PTG 02-116-1	4229
28268	7590	02/27/2006	EXAMINER	
THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	
DATE MAILED: 02/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,637	COOPER ET AL.	
	Examiner	Art Unit	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13, 14, 16-34, 36, 41-44, 52 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) 36, 41-44, 52 and 72-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13, 14, 16-34, 68-71 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>1st page 4,983,642 patent/IDS</u> |

DETAILED ACTION

Response to Amendment

The amendment filed on November 21, 2005 has been considered but is ineffective to overcome the prior art reference and an action on the merits follows.

Election/Restrictions

Newly submitted and amended claims 36, 41-44, 52 and 72-74 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claims change/alter the scope of the originally presented claims to include a kit comprising a router and a knob shaped handle. Further the previously presented claims were drawn to a power tool and removable router base, the claims were silent to any kit or knob shaped handle. Accordingly the newly submitted claims drawn to a kit and knob shaped handle subject matter are not within the same scope of the previously presented claims and are separable and distinct as being drawn to a differing combination. Furthermore, there is no support in the originally filed disclosure for a "kit".

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36, 41-44, 52 and 72-74 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

The amendment filed November 21, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *the grasping member and the connecting member are at an angle of greater than 90 degrees to one another* (clm. 70) and *the grasping member and the connecting member are at an angle of less than 90 degrees to one another* (clm. 71). Accordingly claims 70 and 71 have not been further treated on the merits.

Applicant is required to cancel the new matter in the reply to this Office Action.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on January 20, 2004 has been considered by the Examiner. As noted in the previous Office Action, the reference, number 4,983,642 is listed on the IDS as issued to Imahashi et al., however that patent number is issued to Nakano et al. A copy of the first page of U.S. Patent No. 4,983,642 has been included for references. If there is a typographical error on the IDS, regarding the patent number(s) to be considered, appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 70 and 71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the originally filed written disclosure nor the drawings provide support for the grasping member and the connecting member at an angle greater than 90 degrees to one another (clm 70) or at an angle less than 90 degrees (clm. 71). Examiner notes the originally filed written description provides support for the grasping member and connecting member to be at substantial 90 degree angles to one another, i.e. perpendicular. There is no support for a relative angle at 70 degrees or 45 degrees, which will fall within the ranges specified in claims 70 and 71.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 25, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for the following:

"the base sleeve" (clm. 25)

"the router" (clm. 33)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 16-18, 68, 69, 75 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Hestily (4,051,880). Hestily discloses a power tool (fig. 1) comprising a motor housing (36) adapted to house a motor (42) that is configured for driving a working tool (48); a base (12) coupled to the motor housing (36), said base for supporting the motor housing on a surface; and a generally L-shaped handle (30; fig. 1) having a connecting member (fig. 1) coupled to the base and a grasping member, said handle for manipulating the power tool on a surface, wherein the handle defines a channel (74) with a terminal portion (76) adapted to be attached to an external vacuum source (78). Examiner notes that the vacuum source (78) is external to the channel formed in the handle.

With regard to claim 3, Hestily discloses wherein the base (12) includes: a base sleeve (14) including a generally cylindrical aperture therein for receiving the motor housing; and a support member connected to the base sleeve (18), said support member for supporting the power tool on a workpiece.

With regard to claim 7, Hestily discloses the grasping member substantially parallel to the motor housing (fig. 1).

With regard to claims 16-18, Hestily disclose the connecting member configured to support at least a portion of a human hand disposed between the motor housing and the grasping

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member and wherein the grasping member forms a back hand support for a user's hand when grasping at least a portion of the motor housing. Examiner notes that Hestily can perform such that an operator hand is adjacent the motor housing and the back of the hand is adjacent the grasping member.

With regard to claims 68 and 69, Hestily discloses the grasping member and the connecting member at substantially right angles to one another (fig. 1).

With regard to claim 75, Hestily disclose the external vacuum source (78, 80, 82, 84) not integral with the motor housing. Examiner notes that the motor housing is defined by a casing (36) above which a partition wall (94) is divides the motor and an end cap (88) which houses portions of the vacuum source (col. 2, lines 62-68; fig. 5). Therefore, because of the existence of a partition wall (94) the vacuum source is external the motor housing.

With regard to claim 76, Hestily disclose a grasping member disposed proximal the motor housing (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Vess (4,102,370) asset forth in the previous Office Action. Hestily is silent to the base being removable from the motor housing. Vess teaches in a similar art a router

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having a base (11), a motor (10) and motor housing (12) wherein the base (11) is removable from the motor housing (fig. 2). Vess teaches this construction so as to efficiently adjust the router for cutting depth. Because both Hestily and Vess are concerned with a similar problem (i.e., positioning router cutting depth via telescopically positioning a motor housing within a base) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Hestily's telescopic motor housing and base construction with a removable telescopic motor housing and base construction so as to efficiently position the motor housing relative to the base for accurate cutting depth as taught by Vess.

Claims 4-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Yano (5,640,741). Claims 4-6 and 11 are rejected as noted in the previous Office Action. Hestily does not disclose a grip. Yano teaches in a closely related art, the use of an oblong hand grip (fig. 2) frictionally coupled to a handle of power tool and secured via fasteners (fig. 102a). Yano teaches this construction so as to reduce the vibration felt by the operator of the power tool. Because Hestily and Yano are concerned with a similar problem. (i.e., manual operation of a power tool via a handle) it would have been obvious at the time of the invention to one having ordinary skill in the art to provide Hestily with a handle grip so as to reduce vibration felt by the operator as taught by Yano.

Claims 8, 9 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Lui et al. (6,506,006) as noted in the previous Office Action. Hestily

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discloses the L-shaped handle member to be removable. Examiner notes the L-shaped handle member (32) to be removable to facilitate access to the light bulb (66).

Moreover, Lui teaches in a similar art, a router having a detachable handle (200) constructed of shell portions (230, 240) attached via fasteners (250). Lui teaches the use of a removable/detachable handle so as to facilitate easy access to other elements of the router. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Hestily's handle connection with an easily removable/detachable connection so as to enable and facilitate ease of access to the light bulb (66) and other elements of the router as taught by Lui.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Williams et al. (6,266,850) as noted in the previous Office Action. Hestily does not disclose the grasping member to be adjustably positionable. Williams teaches in a similar art a router having generally L-shaped handles (fig. 2) attached to the router via a connecting member (fig. 3). Williams teaches the handles to have a grasping member, the grasping member to be adjustably positionable (figs. 4-5). Williams teaches this construction of adjustable grasping members so as to better orientate the router to facilitate proper contact with the work piece (col. 1, lines 20-40) and for reduced risk of injury to an operator. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Hestily's non-adjustable handles with adjustably positionable handles so as to allow consistent contact of the router with the work piece and reduce risk to an operator as taught by Williams.

Claims 19-26, 28 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Kopras et al. (6,443,675) or in view of Yano (5,640,741). With regard to claims 19-22, 24 and 25, as noted above, with regard to claim 1, Hestily discloses a power tool comprising a motor housing (36) adapted to house a motor (42) that is configured to drive a working tool (48); a base (12) coupled to the motor housing (36), said base for supporting the motor housing on a surface; a generally L-shaped handle having a connecting member, coupled to the base and a grasping member, said handle (30, 32) for manipulating the power tool on a workpiece. Hestily is silent to a universal grip. Kopras teaches in a similar art a power tool including a motor housing (22) for supporting a motor the motor configured to drive a working tool (20) and a detachable handle (24; col. 8, lines 41-42). Kopras further teaches the detachable handle (24) to have a universal, oblong, frictionally secured grip (70) for efficiently gripping and manipulating the power tool. Because the references are from a similar art it would have been obvious at the time of the invention to one having ordinary skill in the art to provide Hestily with a grip so as to efficiently grip and manipulate the power tool as taught by Kopras.

As to the applicability of prior art reference Kopras et al. under 103(a), Examiner notes the parent application (10/686300) from which the current application claims priority does not provide support for the universal grip as set forth in claim 19. Accordingly the effective filing date of December 8, 2003 is the date used for determining applicability of prior art.

Additionally regarding claims 19 and 27, Yano teaches in a closely related art, the use of an oblong hand grip (fig. 2) frictionally coupled to an outer surface of a handle of power tool such that that the inner surface faces a base and secured via fasteners (fig. 102a). Yano teaches this construction so as reduce the vibration felt by the operator of the power tool. Because

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Hestily and Yano are concerned with a similar problem. (i.e., manual operation of a power tool via a handle) it would have been obvious at the time of the invention to one having ordinary skill in the art to provide Hestily with a handle grip, i.e. vibration material so as to reduce vibration felt by the operator during operation as taught by Yano.

With regard to claim 23, see above with reference to claim 7.

With regard to claim 26, Hestily discloses a terminal zone (76) for coupling a vacuum hose (78).

With regard to claim 28, Hestily discloses a channel (74) formed through the handle (32).

With regard to claims 32-34 see above with reference to claims 16-18.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Kopras et al. (6,443,675) and Lui (6,506,006). Neither Hestily nor Kopras disclose the handle formed of shell portions. It would have been obvious at the time of the invention to one having ordinary skill in the art to construct either Hestily or Kopras of handles of shell portions, because constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlicnman*, 168 USPQ 177, 179.

Moreover, Lui teaches that it is old and well known to construct a handle of a power tool of shell portions. Because the references are from similar art it would have been obvious at the time of the invention to one having ordinary skill in the art to construct Hestily or Kopras of shell portions as taught by Lui.

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Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Koprass et al. (6,443,675) and Williams et al. (6,266,850). Hestily is silent to adjustable grasping member(s). As note above, Williams teaches a router having handles (fig. 2) attached to the router via a connecting member (fig. 3). Williams teaches the handles to have a grasping member, the grasping member to be adjustably positionable (figs. 4-5). Williams teaches this construction of adjustable grasping members so as to better orientate the router to facilitate proper contact with the work piece (col. 1, lines 20-40) and for reduced risk of injury to an operator. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Hestily's non-adjustable handles with adjustably positionable handles so as to allow consistent contact of the router with the work piece and reduce risk to an operator as taught by Williams.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hestily (4,051,880) in view of Koprass et al. (6,443,675) as applied to claim 19 above, and further in view of Turnbull (2,630,152). Hestily is silent to the grasping member angle being between 0° and 20°. Turnbull teaches in a similar art a power tool having a rotary cutter (12) and a handle (figs. 1, 3) that has a grasping member angled between 0° and 20° from an axis normal to the connecting member (fig. 1, 3) of the router. Turnbull teaches this handle construction so as facilitate greater operator control and steady contact to the work piece with limited turning or twisting of the router during operation. Because the references are from a similar art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace,

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Hestily's grasping member with a handle having an angled grasping member so as to facilitate greater operation control as taught by Turnbull.

Response to Arguments

Applicant's arguments filed November 21, 2005 have been carefully considered but they are not persuasive. Applicant's remarks are drawn to the failure of prior art reference, Hestily to disclose "*a handle [that] defines a channel therethrough with a terminal portion adapted to be attached to an external vacuum source*". This however is not persuasive, because as noted in the rejection above, Hestily does disclose a handle (30, 32) having a channel (74), terminal portion (76) and external vacuum source (78). The claim as written does not positively set forth what the vacuum source is external to. Accordingly, because the vacuum source is a created by a blower, house (78) and various other elements and the hose (78) being external to the handle (30, 32) and channel (74) it is clear that the hose (78) is an external vacuum source to the dust channel (74). Accordingly a rejection in view of Hestily is made with regard to the amended claim 1.

As to Applicant's remarks that the secondary reference, Yano fails to disclose at least the "*universal grip coupled to the grasping member and facing the base*", this is not found persuasive. First, the claims as written do not require the universal grip to be facing the base (specifically claims. 4-6, 11). Therefore, Applicant is arguing criticality of structure not positively claimed. Additionally, Examiner notes that the universal grip of Yano is facing the tool, as such; it is an inner side of the grip that faces the tool. The claim as written does not define or positively set forth any sides relative to the universal grip, therefore, the mere recitation, "*...facing the base*" does not patentably distinguish over that of the prior art.

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Accordingly, the rejection with regard to claims 4-6 and 11 Hestily in view of the secondary teaches of Yano is proper and stands.

Regarding Applicant's remarks that Lui et al. teaches a D-shaped handle. This is not found persuasive, because as noted in Lui's figure 2, the handle (200) includes two generally L-shaped shell portions that are detachable from the power tool. Lui clearly teaches the detachability feature to which Hestily is silent. Accordingly proper combination of the references is made and the rejection stands.

With regard to the teachings of prior art references Vess and Turnbull, Applicant argues that neither references, teaches or fairly suggest handle [that] defines a channel therethrough with a terminal portion adapted to be attached to an external vacuum source". Examiner agrees, these references do not teach this feature, however this feature is found in the prior art reference, Hestily as noted above. Furthermore the secondary teaches of Vess and Turnbull are analogous and applicable. Accordingly, proper combination of the references is made and the rejections stand.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

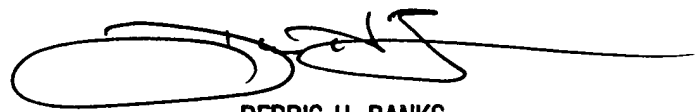
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
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